

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-2, 4-7, 9-36 and 38-39 are presently active in this case. The present Amendment amends Claims 1, 6, 11, 18, 25 and 29 without introducing any new matter and cancels Claim 37.

The outstanding Office Action rejected Claims 1, 4-7, 9 and 10 under 35 U.S.C. §112, second paragraph, as indefinite. Claims 11-14 and 18-21 were rejected under 35 U.S.C. §102(e) as anticipated by Stefik et al. (U.S. Patent No. 6,233,684, herein "Stefik"). Claims 1, 2, 6-7, 15, 22, 25-27, 29-31, 35 and 38-39 were rejected under 35 U.S.C. §103(a) as unpatentable over Stefik in view of Perlman (U.S. Patent No. 6,363,480). Claims 4-5, 9-10, 16-17, 23-24, 28 and 32 were rejected under 35 U.S.C. §103(a) as unpatentable over Stefik in view of Chou et al. (U.S. Patent No. 5,337,357, herein "Chou"). Claims 33-34 and 37 were rejected under 35 U.S.C. §103(a) as unpatentable over Stefik and Perlman and further in view of Hartrick et al. (U.S. Patent No. 5,532,920, herein "Hartrick").

In response to the rejection under 35 U.S.C. §112, second paragraph, Claims 1 and 6 are amended to correct the noted informalities. In particular, the term "enciphered" is deleted. In view of amended Claims 1 and 6, it is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

Claim 1 is amended to recite "a processing part configured to update software or to update a version of a program based on the deciphered data if the deciphered data is judged as being valid and includes data for updating software or to update the version of the program." Claim 11 and 25 are amended to recite a similar feature. Further, Claims 6, 18

and 29 are amended to recite "if the deciphered data is judged as being valid and includes data for updating software or to update the version of the program," for clarification. These features find non-limiting support in Claims 6, 18 and 29 and in the disclosure as originally filed, for example at page 22, lines 3-10. Therefore, the changes to the claims are not believed to raise a question of new matter.¹

In response to the rejection of Claims 11-14 and 18-21 under 35 U.S.C. §102(e), Applicant respectfully requests reconsideration of this rejection and traverses the rejection, as discussed next.

Briefly recapitulating, Claim 18 relates to an enciphered data processing method including: a step of requesting data with respect to a server, a transmitting step enciphering requested data in the server and transmitting enciphered data via a network, a deciphering step receiving and deciphering the enciphered data in an apparatus that includes a printing function, a judging step judging, in the apparatus, whether or not deciphered data obtained by deciphering the enciphered data in the deciphering step is valid; and a processing step updating software or updating a version of a program based on the deciphered data if the deciphered data is judged as being valid and includes data for updating software or to update the version of the program. Claim 11 recites the same features including an additional step of printing the deciphered data. Further, Claims 1 and 6 recite similar features in the context of image forming apparatus connectable to an external apparatus; Claims 25 and 29 recite similar features in the context of an enciphered data processing system.

As explained in Applicant's Specification at page 6, lines 5-12, Applicant's invention improves upon background enciphered data processing methods because it can prevent copying of digital data which is distributed via networks, when the digital data is copyrighted and /or accounting process with respect to the digital data distribution is desired or necessary.

¹ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

Turning now to the applied reference, Stefik discloses a trusted rendering system for controlling the distribution and use of digital works. However, Stefik fails to teach a processing part configured to update software or to update a version of a program based on the deciphered data. On the contrary, Stefik explicitly teaches that a system for controlling the distribution and use of *printed digital works* is disclosed and that the system is able to add watermarks to printed digital works.² Further, the outstanding Office Action did not address this feature related to a processing part configured to update software or to update a version of a program, now claimed in all the independent claims. A system for adding watermarks to printed digital works, as taught by Stefik, *is not* a processing part configured to update software or to update a version of a program based on the deciphered data, as claimed.

Therefore, the applied reference fails to teach or suggest every feature recited in Applicant's claims, so that Claims 11-14 and 18-21 are patentably distinct over Stefik. Accordingly, Applicant respectfully traverses, and requests reconsideration of, the rejection based on Stefik.³

In response to the rejection of Claims 1-2, 6-7, 15, 22, 25-27, 29-31, 35 and 38-39 under 35 U.S.C. §103(a) over Stefik in view of Perlman, Applicant respectfully traverses the rejection and requests reconsideration of the rejection.

Perlman discloses a system and method for a user to encrypt data in a way so that the data cannot be encrypted after a finite period. However, Perlman is also silent on the processing part configured to update software or to update a version of a program based on the deciphered data if the deciphered data includes data for updating software or to update the version of the program, as claimed in independent Claims 1, 6, 25 and 29. Even assuming that the combination of Stefik and Perlman is proper, the applied references fail to teach or

² See Stefik at column 3, lines 6-39 and in Figure 8.

³ See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

suggest all the elements of Applicant's independent Claims. Accordingly, Applicant respectfully requests reconsideration of the rejection of Claims 1-2, 6-7, 15, 22, 25-27, 29-31, 35 and 38-39.

In response to the rejection of Claims 4-5, 9-10, 16-17, 23-24, 28 and 32 under 35 U.S.C. §103(a) over Stefik in view of Chou and the rejection of Claims 33-34 and 37 under 35 U.S.C. §103(a) over Stefik and Perlman in further view of Hartrick, since these claims depend upon independent Claims 1, 6, 11, 18, 25 and 29 and the rejection of the independent claims is believed to be overcome, Applicant traverses these rejections. Further, the references Chou and/or Hartrick do not remedy the deficiencies of the references Stefik and/or Perlman, taken individually or in combination, as discussed above. Accordingly, Applicant respectfully requests reconsideration of these rejections under 35 U.S.C. §103(a).

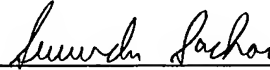
The present Amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present Amendment is believed to overcome outstanding rejections under 35 U.S.C. §112, second paragraph, 35 U.S.C. §102(e) and 35 U.S.C. §103(a), the present Amendment places the application in better form for consideration on appeal. In addition, the present Amendment is not believed to raise new issues because the changes to Claims 1, 6, 11, 18, 25 and 29 merely recite limitations previously introduced in independent Claims 6, 18 and 29 that were not addressed by the outstanding Office Action. It is therefore respectfully requested that under 37 C.F.R. §1.116 the present Amendment be entered.

Consequently, in view of the present Amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-2, 4-7, 9-36 and 38-39 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Surinder Sachar
Registration No. 34,423